

REMARKS

In the Office Action mailed September 30, 2003, claims 1-7 and 24 were rejected under 35 U.S.C. 112, first paragraph. Applicant respectfully traverses this rejection.

The Examiner is thanked for a telephonic interview on October 22, 2003 in which claims 1 and 24 were discussed. The Examiner indicated the amendment to claim 1 would make the claim allowable, and suggested amendments to claim 24.

The Amendments

Claim 1 has been amended as suggested by the Examiner to recite "treating". The amendment to claim 1 is supported by the specification as filed on page 3, lines 24-25; page 13, lines 13-16; page 1, lines 33-35; page 1, line 37 through page 2, line 2. Claim 24 has been amended to list three ocular diabetic complications. The amendment to claim 24 is supported by the specification as filed on page 32, lines 13-15; page 27, line 5 through page 28, line 11; page 26 through page 27, line 4; and page 13, lines 17-18. No new matter is added by any amendment.

Rejection of claims 1-7 under 35 U.S.C. 112, first paragraph

In the Office Action mailed September 30, 2003, claims 1-7 were rejected under 35 U.S.C. 112, first paragraph. The Office Action stated: "claimed 1-7 are directed to the method of 'preventing cataracts, retinopathy, lens cell damage and retinal cell damage caused by diabetes'. The instant specification fails to describe how the 'prevention' is done. The examples in the specification are directed to treating."

In the interview on October 22, 2003, the Examiner indicated an amendment to recite "treating" in claim 1 would overcome the rejection. The Applicant thanks the Examiner for the helpful suggestion and has made the suggested amendment to claim 1. As stated by the Examiner, the examples in the specification as directed to treating, so it is believed the rejection

is overcome. Reconsideration and withdrawal of the rejection is respectfully requested.

Rejection of claim 24 under 35 U.S.C. 112, first paragraph

In the Office Action mailed September 30, 2003, claim 24 was rejected under 35 U.S.C. 112, first paragraph. The Office Action stated "claim 24 is directed to a method of treating ocular complication selected from the group consisting of: 'loss of PKC in eye lens cell, polyol accumulation in the eye, galactitol formation from galactose in the lens cell, vascular leakage in the eye and the expression of aldose reductase in the retina'. Such method requires treatment of unspecified disease and no evidence indicates that the treatable disease was known to the applicant."

In response, claim 24 has been amended to specify a method of treating an ocular diabetic complication selected from the group consisting of: polyol accumulation in the eye, galactitol formation from galactose in lens cells, and expression of aldose reductase in the retina. Claim 24 recites treating complications that are specific to diabetes, the recited disease. As discussed in the Interview with the Examiner October 22, 2003, polyol accumulation in the eye and galactitol formation from galactose in lens cells are specific ocular complications that occur with diabetes. Aldose reductase is an enzyme that catalyzes the reduction of aldehyde sugars to their alcohol forms. In diabetic retinal cells, there is more glucose present than normal, and aldose reductase expression is higher. Therefore, expression of aldose reductase in the retina is also specific to diabetes. (See page 1, line 35 through page 2, line 4).

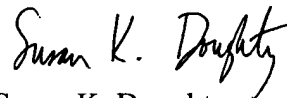
The ocular diabetes complications claimed in claim 24 are also described in the specification. On page 32, lines 10-24, a study is described where diabetes is induced in dogs. Compounds of the invention are given to the diabetic dogs, and polyol accumulation in the eye is 50% normalized. On page 27, line 5 through page 28, line 11, inhibition of galactitol formation from galactose in lens cells by the compounds of the invention is described. On page 26 through page 27, line 4, aldose reductase expression is found to be inhibited in lens cells by treatment with the compounds of the invention.

The examples shown in the specification provide evidence that the inventors had possession of the claimed invention at the time the application was filed. Reconsideration and withdrawal of the rejection is respectfully requested.

CONCLUSION

It is believed the application is in condition for allowance. Reconsideration and withdrawal of all rejections is respectfully requested. If there are any issues remaining to patentability, the Examiner is respectfully requested to telephone the undersigned. It is believed no fee is due with this submission. If this is incorrect, however, please deduct the appropriate fee, including the fee for any extensions of time required from Deposit Account No. 07-1969.

Respectfully submitted,



Susan K. Doughty
Reg. No. 43,595

GREENLEE, WINNER AND SULLIVAN, P.C.
5370 Manhattan Circle, Suite 201
Boulder, CO 80303
Telephone: (303) 499-8080; Facsimile: (303) 499-8089
E-mail: winner@greenwin.com

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